

#13/85
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(703) 872-9302 Technology Center 3700, Examiner Mendez at the US Patent
and Trademark Office, Arlington, VA 22313-1450

PATENT
Attorney Docket No.: CB-7-2

On May 13, 2003
By Katie Zarzana

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MICHAEL A. BAKER et al.

Application No.: 09/586,295

Filed: June 2, 2000

For: SYSTEMS FOR ELECTROSURGICAL
TISSUE TREATMENT IN THE PRESENCE OF
ELECTRICALLY CONDUCTIVE FLUID

Assistant Commissioner for Patents
Washington, D.C. 20231

Examiner: M. Mendez

Art Unit: 3739

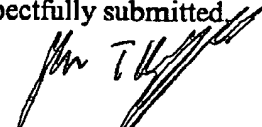
RESPONSE

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Sir:

In response to the Communication mailed May 6, 2003, Applicant encloses a copy of the Jury Verdict from the ArthroCare Corporation v. Smith & Nephew, Inc. case. As you can see, the jury found that the Smith & Nephew products (the Saphyre, Control RF and ElectroBlade) infringe all sixteen asserted claims of the three patents in suit (U.S. Patent Nos. 5,697,882; 5,697,536 and 6,224,592). In addition, the jury rejected all of Smith & Nephew's invalidity contentions thereby upholding the validity of all sixteen asserted claims. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,


John T. Raffle
Reg. No. 38,585

ArthroCare Corporation
680 Vaqueros Ave.
Sunnyvale, CA 94085-3523

405

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ARTHROCARE CORPORATION,

Plaintiff,

v.

SMITH & NEPHEW, INC.

Defendant.

C.A. No. 01-504-SLR

SMITH & NEPHEW, INC.,

Counterclaim Plaintiff,

v.

ARTHROCARE CORPORATION, AND
ETHICON, INC.,

Counterclaim Defendants.

JURY VERDICT

We, the jury, unanimously find as follows:

I. INFRINGEMENT OF ARTHROCARE'S PATENTS

A. The '536 Patent

Direct Infringement by Smith & Nephew of the '536 Patent

1. Do you find that Arthrocare has shown by a preponderance of the evidence that Smith & Nephew has directly infringed any of the following claims of the '536 patent with its Saphyre, ElectroBlade, or Control RF products? ("YES" answers to these questions are findings for ArthroCare. "NO" answers are findings for Smith & Nephew.)

Patent	Claim	YES	NO	YES	NO	YES	NO
'536	46	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'536	47	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'536	56	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>

Inducement of Infringement by Smith & Nephew

2. Do you find that Arthrocare has shown by a preponderance of the evidence that Smith & Nephew has induced infringement by others of any of the following claims of the '536 patent with its Saphyre, ElectroBlade, or Control RF products? ("YES" answers to these questions are findings for ArthroCare. "NO" answers are findings for Smith & Nephew.)

Patent	Claim	YES	NO	YES	NO	YES	NO
'536	46	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'536	47	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'536	56	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>

Contributory Infringement by Smith & Nephew

3. Do you find that Arthrocare has shown by a preponderance of the evidence that Smith & Nephew has contributed to the infringement any of the following claim: of the '536 patent with its Saphyre, ElectroBlade, or Control RF products? ("YES" answers to these questions are findings for ArthroCare. "NO" answers are findings for Smith & Nephew.)

Claim	Question	Saphyre	ElectroBlade	Control RF
'536'	46	<input checked="" type="radio"/> YES <input type="radio"/> NO	<input checked="" type="radio"/> YES <input type="radio"/> NO	<input checked="" type="radio"/> YES <input type="radio"/> NO
'536'	47	<input checked="" type="radio"/> YES <input type="radio"/> NO	<input checked="" type="radio"/> YES <input type="radio"/> NO	<input checked="" type="radio"/> YES <input type="radio"/> NO
'536'	56	<input checked="" type="radio"/> YES <input type="radio"/> NO	<input checked="" type="radio"/> YES <input type="radio"/> NO	<input checked="" type="radio"/> YES <input type="radio"/> NO

B. The '882 Patent**Validity of ArthroCare's Certificate of Correction for the '882 Patent**

4. Do you find that Smith & Nephew has shown by clear and convincing evidence that the certificate of correction for claim 1 of the '882 patent is invalid? (A "YES" answer to this question is a finding for Smith & Nephew. A "NO" answer is a finding for ArthroCare.)

Patent	Claim	Invalid?
'882	1	YES <input type="radio"/> NO <input checked="" type="radio"/>

Answer questions 5-6 only if you have answered "NO" in question 4.

Inducement of Infringement by Smith & Nephew of the '882 Patent

5. Do you find that Arthrocare has shown by a preponderance of the evidence that Smith & Nephew has induced infringement by others of any of the following claims of the '882 patent with its Saphyre or Control RF products? ("YES" answers to these questions are findings for ArthroCare. "NO" answers are findings for Smith & Nephew.)

Patent	Claim	Induced?	Induced?
'882	13	YES <input checked="" type="radio"/> NO <input type="radio"/>	
'882	17	YES <input checked="" type="radio"/> NO <input type="radio"/>	YES <input checked="" type="radio"/> NO <input type="radio"/>
'882	54		YES <input checked="" type="radio"/> NO <input type="radio"/> YES <input checked="" type="radio"/> NO <input type="radio"/>

Contributory Infringement by Smith & Nephew of the '882 Patent

6. Do you find that Arthrocare has shown by a preponderance of the evidence that Smith & Nephew has contributed to the infringement of any of the following claims of the '882 patent with its Saphyre or Control RF products? ("YES" answers to these questions are findings for ArthroCare. "NO" answers are findings for Smith & Nephew.)

Patent	Claim	YES	NO	YES	NO
'882	13	<input checked="" type="radio"/> YES	<input type="radio"/> NO		
'882	17	<input checked="" type="radio"/> YES	<input type="radio"/> NO		<input checked="" type="radio"/> YES <input type="radio"/> NO
'882	54			<input checked="" type="radio"/> YES <input type="radio"/> NO	<input checked="" type="radio"/> YES <input type="radio"/> NO

C. The '592 Patent

Inducement of Infringement by Smith & Nephew of the '592 Patent

7. Do you find that Arthrocare has shown by a preponderance of the evidence that Smith & Nephew has induced infringement by others of any of the following claims of the '592 patent with its Saphyre, ElectroBlade, or Control RF products? ("YES" answers to these questions are findings for ArthroCare. "NO" answers are findings for Smith & Nephew.)

Claim	Number	YES	NO	YES	NO	YES	NO
'592	1	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'592	3	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'592	4	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'592	11	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'592	21					<input checked="" type="radio"/>	<input type="radio"/>
'592	23	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'592	26	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'592	27	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'592	32	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>	<input checked="" type="radio"/>	<input type="radio"/>
'592	42					<input checked="" type="radio"/>	<input type="radio"/>

Contributory Infringement by Smith & Nephew of the '592 Patent

8. Do you find that Arthrocare has shown by a preponderance of the evidence that Smith & Nephew has contributed to the infringement of any of the following claims of the '592 patent with its Saphyre, ElectroBlade, or Control RF products? ("YES" answers to these questions are findings for ArthroCare. "NO" answers are findings for Smith & Nephew.)

Patent	Claim	Saphyre		ElectroBlade		Control RF	
'592	1	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO
'592	3	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO
'592	4	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO
'592	11	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO
'592	21					<input checked="" type="radio"/> YES	<input type="radio"/> NO
'592	23	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO
'592	26	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO
'592	27	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO
'592	32	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO	<input checked="" type="radio"/> YES	<input type="radio"/> NO
'592	42					<input checked="" type="radio"/> YES	<input type="radio"/> NO

II. VALIDITY OF ARTHROCARE'S PATENTS

A. Anticipation of ArthroCare's Patents

9. Do you find that Smith & Nephew has shown by clear and convincing evidence that the following claims of the patents-in-suit are invalid due to anticipation? (A "YES" answer to this question is a finding for Smith & Nephew. A "NO" answer is a finding for ArthroCare.)

The '536 Patent

Anticipation	
Claim 46	YES <input checked="" type="radio"/> NO
Claim 47	YES <input checked="" type="radio"/> NO
Claim 56	YES <input checked="" type="radio"/> NO

The '882 Patent

Anticipation	
Claim 13	YES <input checked="" type="radio"/> NO
Claim 17	YES <input checked="" type="radio"/> NO
Claim 54	YES <input checked="" type="radio"/> NO

The '592 Patent

Anticipation	
Claim 1	YES <input checked="" type="radio"/> NO
Claim 3	YES <input checked="" type="radio"/> NO
Claim 4	YES <input checked="" type="radio"/> NO
Claim 11	YES <input checked="" type="radio"/> NO
Claim 21	YES <input checked="" type="radio"/> NO
Claim 23	YES <input checked="" type="radio"/> NO
Claim 26	YES <input checked="" type="radio"/> NO
Claim 27	YES <input checked="" type="radio"/> NO
Claim 32	YES <input checked="" type="radio"/> NO
Claim 42	YES <input checked="" type="radio"/> NO

D. Enablement of ArthroCare's Patent

10. Do you find that Smith & Nephew has shown by clear and convincing evidence that the following claims are invalid for lack of enablement? (A "YES" answer to this question is a finding for Smith & Nephew. A "NO" answer is a finding for ArthroCare.)

Patent	Claims	Invalid
'882	13, 17, 54	YES <input checked="" type="radio"/> NO

Each Juror should sign the verdict form to reflect that a unanimous verdict has been reached.

Dated: May 12, 2003

Deephire Adkins
Foreperson

Stacy Miranda

Christine M. Murray

Glean Hansen

Bernard H. Evans

Jeff L. Byers

Carol Hansen

John L. Hansen

Atty Docket No. CB-7-2

PTO FAX NO.: 1 (703) 872-9303

Attn.: Technology Center 3700

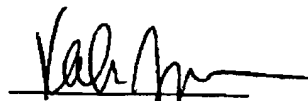
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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following Response for Michael A. Baker et al., Application No. 09/586,295, filed June 2, 2000, is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Number of pages being transmitted, including this page: 12.

Dated: May 13, 2003


Katie Zarzafa

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